

REMARKS

In the outstanding Office Action, the Examiner took the following actions:

(a) objected to the language and format of the Abstract;

(b) rejected claims 12 and 30 under 35 U.S.C. § 112, second paragraph, on the grounds of insufficient antecedent basis;

(c) rejected claims 1-8 and 11 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,303,312 to Comerford et al. ("Comerford");

(d) rejected claims 1-5, 8, and 33 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,666,438 to Beermink et al. ("Beermink '438");

(e) rejected claims 6, 7, 9-16, 18-32, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Beermink '438 in view of U.S. Patent No. 5,682,439 to Beermink et al. ("Beermink '439"); and

(f) rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Beermink '438 in view of Beermink '439 and U.S. Patent No. 5,970,170 to Kadashevich et al. ("Kadashevich").

By this reply, Applicant amends claims 12-14 and 30-32, and provides a Substitute Abstract. Claims 1-34 remain pending in this application. This reply does not introduce any new matter.

I. Objection to the Abstract

Applicant provides a substitute Abstract as an attachment to this reply. Applicant respectfully submits that the substitute Abstract has the proper language and format.

II. Rejection of claims 12 and 30 under 35 U.S.C. § 112, second paragraph

Applicant amends claims 12-14 to replace the phrase "the presented pattern" with the phrase "the best writing symbol pattern," which is recited in independent claim 1, from which claims 12-14 depend. Applicant also amends claims 30-32 to

replace the phrase "the presented interpretation" with the phrase "the best interpretation," which is recited in independent claim 15, from which claims 30-32 depend. Applicant submits that these amendments remedy any antecedent basis deficiencies, and thus, Applicant requests withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

III. Rejection of claims 1-8 and 11 under 35 U.S.C. § 102(b) as allegedly being anticipated by Comerford

Applicant respectfully traverses the rejection of claims 1-8 and 11 as anticipated by Comerford. Comerford fails to teach each and every limitation recited in those claims.

Independent claim 1 calls for a combination including, for example,

comparing the handwritten pattern to a plurality of templates . . . wherein at least two of the plurality of templates comprise different ones of the plurality of writing symbol patterns which represent different ways of writing a single symbol.

Comerford fails to teach at least these elements. In Comerford,

[w]hen the user has completed the character The recognizer constructs from the completed glyph an ordered sequence of designators 36 corresponding to the template line segments The recognizer then compares the ordered sequence to entries in a reference table, as shown at 37. If the ordered sequence matches an entry in the table, the corresponding computer code entry is output at 38. Comerford, column 8, lines 16-31.

Comerford does not disclose the content of the entries in reference table 37.

Thus, Comerford cannot teach that the entries are "a plurality of templates . . . wherein at least two of the plurality of templates comprise different ones of a plurality of writing symbol patterns, which represent different ways of writing a single symbol," as recited in independent claim 1. Although FIGS. 4 and 8-10 of Comerford show various ways of

writing letters, those letters are not entries in reference table 37, but rather, are user-created characters, the kind that are encoded into ordered sequence of designators 36, and are then compared to entries in reference table 37. See Id. at column 7, lines 50-60; and column 8, lines 16-31. Since the letters in FIGS. 4 and 8-10 of Comerford are not entries in reference table 37, Comerford fails to teach "comparing the handwritten pattern to a plurality of templates . . . wherein at least two of the plurality of templates comprise different ones of a plurality of writing symbol patterns, which represent different ways of writing a single symbol," as recited in independent claim 1. For at least this reason, Comerford fails to anticipate independent claim 1. Applicant respectfully requests reconsideration of this rejection of independent claim 1, and the timely allowance of independent claim 1.

Claims 2-8 and 11 each depend from independent claim 1, and are allowable for at least the reasons stated above with respect to claim 1. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

IV. Rejection of claims 1-5, 8, and 33 under 35 U.S.C. § 102(b) as allegedly being anticipated by Beernink '438

Applicant respectfully traverses the rejection of claims 1-5, 8, and 33 as being anticipated by Beernink '438. Beernink '438 fails to teach each and every limitation recited in those claims.

Independent claim 1 calls for a combination including, for example,

comparing the handwritten pattern to a plurality of templates . . . wherein at least two of the plurality of templates comprise different ones of the plurality of writing symbol patterns which represent different ways of writing a single symbol.

Beernink '438 fails to teach at least these elements. As stated in Beernink '438, "[t]he present invention makes use of a recognizer implemented by CPU 12 to recognize ink strokes input by a user with a stylus 38. The recognizer analyzes the entered ink and attempts to match the ink to a letter, word, shape, or other symbol present in a database accessible to the recognizer." Beernink '438, column 7, lines 19-23. Beernink '438 does not describe the letter, word, shape, or other symbol, matched to the ink strokes input by the user, and thus, Beernink '438 cannot teach that at least two of the letter, word, shape, or other symbol, "comprise different ones of a plurality of writing symbol patterns, which represent different ways of writing a single symbol," as recited in independent claim 1.

While Beernink '438 discloses different letter styles in a letter style screen 76 shown in FIGS. 6a, 6b, 7, and 8, Beernink '438 does not teach that the ink strokes input by a user are compared to the letter styles. Rather, Beernink '438 discloses,

[r]eferring now to FIG. 8 A user selects one of the characters 89 of which he wishes to modify the letter style CPU 12 then displays style letters 95 for the selected character 89. For each displayed style letter 95, the user can select whether he or she writes that letter style either "sometimes" or "rarely" by actuating one of toggles 97 Computer system 10 automatically saves adaptive learning data associated with the style letters selected and modified by the user. Beernink '438, column 10, lines 8-22 and 42-44.

Since Beernink '438 does not describe the letter, word, shape or other symbol, matched with the ink strokes input by the user, and Beernink '438 does not teach that the ink strokes input by the user are compared to the letter styles in letter style screen 76, Beernink '438 fails to teach or suggest, "comparing the handwritten pattern to a plurality of templates . . . wherein at least two of the plurality of templates comprise

different ones of the plurality of writing symbol patterns which represent different ways of writing a single symbol,” as recited in independent claim 1. For at least this reason, Beernink '438 fails to anticipate independent claim 1. Applicant respectfully requests reconsideration of the rejection of claim 1, and the timely allowance of claim 1.

Claims 2-5 and 8 each depend from independent claim 1, and are allowable for at least the reasons stated above with respect to claim 1. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

Independent claim 33, while of different scope, recites elements similar to those recited in independent claim 1. Thus, Beernink '438 fails to teach each and every feature recited in independent claim 33. Accordingly, independent claim 33 is allowable at least for the same reasons discussed above with respect to independent claim 1. Applicant respectfully requests the timely allowance of independent claim 33.

V. Rejection of claims 6, 7, 9-16, 18-32, and 34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beernink '438 in view of Beernink '439

Applicant respectfully traverses the rejection of claims 6, 7, 9-16, 18-32, and 34, as being unpatentable over Beernink '438 in view of Beernink '439. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant

combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1, from which claims 6, 7, and 9-14 depend, calls for a combination including, for example,

comparing the handwritten pattern to a plurality of templates . . . wherein at least two of the plurality of templates comprise different ones of the

plurality of writing symbol patterns which represent different ways of writing a single symbol.

The Examiner alleges that letter style screen 76 in FIG. 6A of Beernink '438 corresponds to the claimed "plurality of templates," and that letter style screen 76 in FIG. 8 also corresponds to the claimed "plurality of templates." See Office Action, page 7. This is not correct. Beernink '438 discloses,

"[r]eferring now to FIG. 8 A user selects one of the characters 89 of which he wishes to modify the letter style CPU 12 then displays style letters 95 for the selected character 89. For each displayed style letter 95, the user can select whether he or she writes that letter style either "sometimes" or "rarely" by actuating one of toggles 97 Computer system 10 automatically saves adaptive learning data associated with the style letters selected and modified by the user." Id., column 10, lines 8-22 and 42-44.

However, Beernink '438 does not teach or suggest that the ink strokes input by a user are compared to the letter styles in letter style screen 76. Thus, the letter styles in letter style screen 76 cannot correspond to the claimed "plurality of templates," since independent claim 1 requires the step of "comparing the handwritten pattern to a plurality of templates." In view of the mischaracterization of Beernink '438, above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of independent claim 1. Thus, the Examiner has failed to clearly articulate a reason why claims 6, 7, and 9-14, which depend from independent claim 1, would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 6, 7, and 9-14, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

Independent claims 15 and 34, while of different scope, recite elements similar to those recited in independent claim 1. Thus, independent claims 15 and 34 are allowable over Beernink '438 and Beernink '439, for at least the reasons discussed above with respect to claims 6, 7, and 9-14. Claims 16 and 18-32 depend from independent claim 15, and thus, are allowable for at least the same reasons that independent claim 15 is allowable. In addition, these dependent claims recite unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

VI. Rejection of claim 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beernink '438 in view of Beernink '439 and Kadashevich

Applicant respectfully traverses the rejection of claim 17 as being unpatentable over Beernink '438 in view of Beernink '439 and Kadashevich. A *prima facie* case of obviousness has not been established. Claim 17 depends from claim 15, and thus includes all the elements thereof. As set forth above, Beernink '439 fails to teach or suggest at least "comparing the handwritten pattern to a plurality of templates . . . wherein at least two of the plurality of templates comprise different one of the plurality of writing symbol patterns which represent different ways of writing a single symbol," as recited in claim 15, and required by claim 17. Beernink '439 and Kadashevich fail to cure the deficiencies of Beernink '438. That is, Beernink '439 and Kadashevich also fail to teach or suggest at least "comparing the handwritten pattern to a plurality of templates . . . wherein at least two of the plurality of templates comprise different one of the plurality of writing symbol patterns which represent different ways of writing a single symbol," as recited in claim 15 and required by claim 17.

In view of the mischaracterization of Beemink '438 discussed above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the combination of claim 17. Thus, the Examiner has failed to clearly articulate a reason why claim 17 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 17, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of the pending rejections in this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.



Dated: March 21, 2008

By: _____
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Attachments: Attached please find a **Substitute Abstract (1 page)**.